

Remarks

Claims 1-18 are pending in the instant application.

Provisional Election With Traverse

The Examiner has required an election under 35 U.S.C. § 121 of one of three groups cast by the Examiner. The Examiner contends that the groups are distinct, each from each other.

In order to be fully responsive, Applicants hereby provisionally elect, *with traverse*, the invention of Group I, drawn to an isolated nucleic acid molecule comprising the pVGI.1 vector, an aqueous solution comprising said nucleic acid molecule, a host cell comprising said nucleic acid molecule and a method of making said host cell, represented by pending claims 1-5 and 10-14.

With respect to the Examiner's division of the invention into three groups and the reasons stated therefore, Applicants respectfully traverse.

Preliminarily, while the Examiner has restricted claims 1-18 into three groups, Applicants note that the claims of Group III, claims 2 and 11, are included in Group I, claims 1-5 and 10-14. Furthermore, the Examiner alleges that the claims of Group III are drawn to an animal comprising the nucleic acid molecule comprising the pVGI.1 vector. However, claims 2 and 11 are drawn to a composition comprising the pVGI.1 vector. Lastly, the Examiner alleges that Group I is drawn to an aqueous solution comprising the pVGI.1 vector. Applicants submit that none of the claims of Group I are drawn to an aqueous solution comprising the pVGI.1 vector. Applicants respectfully request clarification regarding these matters in the current Restriction Requirement.

M.P.E.P. § 806.05(h) states, "The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product." The Examiner alleges that the vector of Group I can also be used to produce a protein product recombinantly. However, Applicants submit that using such a vector to treat a patient comprising administering to a patient a nucleic acid comprising the vector entails producing a protein product recombinantly. Applicants thus believe that Group I and Group II are not patentably distinct. Consequently, Applicants maintain that the product claims (Group I) and the process of using claims (Group II) should be examined together.

In view of the above, Applicants respectfully request that the Examiner reconsider and withdraw the restriction requirement and examine the subject matter of Groups I-II together in the present application.

If the restriction requirement is maintained, Applicants request rejoinder of the claims of Group I and II once the claims of Group I are found allowable. In light of the decisions in *In re Ochiai*, 71 F.3d 1565, 37 USPQ2d 1127 (Fed. Cir. 1995) and *In re Brouwer*, 77 F.3d 422, 37 USPQ 2d 1663 (Fed. Cir. 1996), a notice was published in the Official Gazette which set forth new guidelines for the treatment of product and process claims. See 1184 OG 86 (March 26, 1996). Specifically, the notice states that:

in the case of an elected product claim, rejoinder will be permitted when a product claim is found allowable and the withdrawn process claim depends from or otherwise includes all the limitations of an allowed product claim.

Id. Accordingly, if claims of Group I are found allowable, Applicants respectfully request that the claims of Group II be rejoined and examined for patentability. See also M.P.E.P. § 821.04.

Further, Applicants note that the Examiner has acknowledged that the claims of Group I and Group III are linked. See Paper No. 1103, page 3. As indicated in the Restriction Requirement, "Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to the examination in the instant application." Accordingly, should the Restriction Requirement be made final, Applicants respectfully request that if any of the claims of Group I, *i.e.*, claims 1-5 and 10-14, are found allowable, then the claims of Group III be rejoined and examined for patentability.

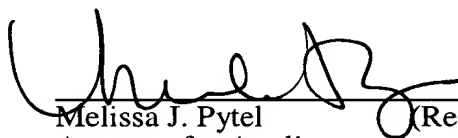
Applicants retain the right to petition from the restriction requirement under 37 C.F.R. § 1.144.

Conclusion

Applicants respectfully request that the above-made remarks be entered and made of record in the file history of the instant application. If there are any fees due in connection with the filing of this paper, please charge the fees to our Deposit Account No. 08-3425. If a fee is required for an extension of time under 37 C.F.R. § 1.136 that is not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

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